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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,607	03/12/2001	Darrel D. Cherry	10007622-1	3150

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

LEZAK, ARRIENNE M

ART UNIT PAPER NUMBER

2143

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/804,607

Applicant(s)

CHERRY, DARREL D.

Examiner

Arrienne M. Lezak

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6,8,9,11-16 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6,8,9,11-16 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8 April 2005 has been entered.

2. Examiner notes that Claims 11 & 21 have been amended, and no claims have been cancelled or added. Claims not explicitly addressed herein are found to be addressed within prior Office Action dated 4 January 2005 as reiterated herein below.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Newly amended Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Examiner finds the amended claim language, "without using the PDA" to be confusing in light of the paragraph as a whole. In other words, as written, communication of information is "from the PDA", yet in light of the amended claim language, communication of information is done "without

using the PDA". Correction is required. For purposes of examination the additional newly added language, "without using the PDA" will not be considered.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Newly Amended Claims 11 & 21 and Original Claims 6, 8, 9 & 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over extensive consideration of US Patent Pub. No. US 2002/0018234 A1 to Fu.

7. Regarding Newly Amended Claim 11, Newly Added Claim 21 & Original Claims 6, 13 & 15, Fu discloses a print method and system for use with an intranet, the intranet being configured to store information corresponding to documents available for printing remotely, (Fig. 1 & Claims 1-28), said print system comprising:

- communicatively coupling a personal digital assistant (PDA), (per pending Claim 13), to an intranet, the intranet providing access to print information, (document retrieval system), corresponding to documents available for printing, (Figs. 1-5 & paragraphs #0021-0054) ;
- receiving document reference information corresponding to each document available for printing (from the document retrieval system),

(Figs. 1-5 & paragraphs #0021-0054), (Examiner notes that as Fu teaches the transmission of document print information generally to a PDA, and as a PDA is capable of displaying a list of documents available for printing, it would have been obvious to transmit document information pertaining to more than one document for display on the PDA);

- storing document reference information with the PDA, (Figs. 1-5 & paragraphs #0021-0054), (Examiner notes that as a PDA has a memory/storage capability, storage of document reference information on the PDA would have been obvious for purposes of transportation convenience at a remote location); and
- displaying, on the PDA, for the user, information corresponding to each document available for printing, the information being selectable such that selection of first information associated with a first document available for printing enables identification of the first document as a document to be printed at the network printer, (Figs. 1-5 & paragraphs #0021-0054), (Examiner notes that it is well-known that a PDA is capable of displaying information, which information is selectable).
- wherein the step of enabling retrieval of printer information, (per pending Claim 15), comprises the steps of communicatively coupling a personal digital assistant (PDA) to the network printer on the intranet/Internet, (Figs. 1-5 & paragraphs #0021-0054);

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- receiving printer information, (IP address – per pending Claim 6), from the network printer; and storing the printer information with the PDA, (Figs. 1-5 & paragraphs #0021-0054), (Examiner notes that as a PDA has a memory/storage capability, storage of printer information on the PDA would have been obvious for purposes of transportation convenience at a remote location); and
- communicating, from the PDA, (remote print request system), to the document retrieval system, the printer information and the document reference information corresponding to a document to be printed such that the information for printing the document is communicated to the (remote – per pending Claim 15) network printer via the intranet and the Internet with the document being printed at the (remote) network printer, (Figs. 1-5 & paragraphs #0057-0063), directly from the document retrieval system without further use of the remote print request system, (Fig. 4; paragraphs #0042, 0060, 0061; and Claim 17).

Thus, Newly Amended Claim 11, Newly Added Claim 21 & original Claims 6, 13 & 15 are unpatentable over extensive consideration of the teachings of Fu.

8. Regarding Claims 8, 9, 12, 14 & 16, Fu discloses a method, system and computer-readable medium for remotely printing a document, (Fig.1), wherein the step of facilitating printing of the document, (per pending Claims 12 & 16), comprises the steps of:

- communicatively coupling a personal digital assistant (PDA) to an intranet, the intranet providing access to print information corresponding to documents available for printing, (Figs. 1-5 & paragraphs #0021-0054);
- receiving and storing an authorization code on the PDA, (per pending Claim 9), wherein the step of providing printer information comprises the step of the document retrieval system providing the authorization code to the intranet, (remote print request system), such that the user may be identified as being authorized access to request printing of a document at the network printer, (per pending Claims 8 & 14), (Figs. 1-5 & paragraphs #0021-0054), (Examiner notes that as a PDA has a memory/storage capability, storage of an authorization code on the PDA would have been obvious for purposes of security and access authorization when transmitting/receiving from a remote location);
- (the PDA) providing (stored) printer information and information corresponding to a document to be printed, to the intranet, (Figs. 1-5 & paragraphs #0021-0054), (Examiner notes that as a PDA has a memory/storage capability and transmission means, storage of document and printer information on the PDA would have been obvious for purposes of transmitting/receiving from a remote location);
- (the PDA) retrieving print information (from the intranet) corresponding to the document to be printed at the network printer, (Figs. 1-5 & paragraphs #0021-0054), (Examiner notes that as a PDA has a memory/storage

- capability and transmission means, storage of document and printer information on the PDA would have been obvious for purposes of transmitting/receiving from a remote location); and
- (the PDA) communicating the print information to the network printer, via the Internet, such that the network printer prints the document, (Figs. 1-5 & paragraphs #0021-0054).

Thus, Claims 8, 9, 12, 14 & 16 are unpatentable over extensive consideration of the teachings of Fu.

### ***Response to Arguments***

9. Applicant's arguments filed 8 April 2005, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

10. Applicant has substantively amended Claims 11 & 21, which claims are rejected as enumerated herein above. Applicant asserts that newly amended/added claims are patentably distinct from the prior art because they recite additional limitations enumerating direct communication between the document retrieval system and the printer without additional interaction with the remote print request system. Examiner disagrees finding that Fu discloses the same, as noted herein above. Thus, Examiner reiterates the original grounds for rejection as applied to substantively amended Claims



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11 & 21, as Examiner finds Fu to fully encompass and anticipate all claims, (original, amended and new), as enumerated by Applicant.

***Conclusion***

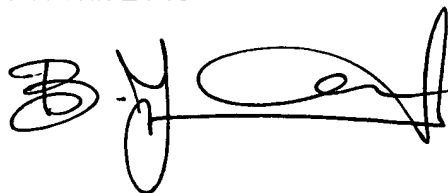
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (571)-272-3916. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arrienne M. Lezak  
Examiner  
Art unit 2143

AML

A handwritten signature in black ink, appearing to read 'A. M. Lezak', with a stylized flourish at the end.